Application No. 10/089,810
Case No. FA 1068

REMARKS

Status of the Application

In the Office Action, Claims 10-22 stand as rejected under 35 U.S.C. §102(e) and Claims 23-24 stand as rejected under 35 U.S.C. §103(a). The pending claims have not been amended in this Response. No new matter has been added.

Rejections Under 35 U.S.C §102

Claims 10-22 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,261,645 (Betz et al.) for the reasons of record as set forth in Paragraph No. 2 of the Office Action mailed in June of 2003. More specifically, the Examiner claims that the clear topcoat disclosed by Betz is "a lacquer coating or sealing coat *inherently* since it is produced by a method identical or substantially identical process to that of claimed invention." To support her position, the Examiner relies on MPEP 2111.02 and 2112.01, which she claims states that "where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, *claimed properties or functions are presumed to be inherent.*" The Examiner also cited to In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990) as standing for the proposition that "'When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicants has the burden of showing that they are not.'"

Applicants, however, respectfully believe that the Examiner's characterization of Betz et al. is incorrect, particularly with respect to the Examiner's comments directed to the reaction of polyisocyanurate of hexamethylene (hexane) diisocyanate, i.e. polyisocyanates based on acyclic aliphatic diisocyanate have 8 C atoms (column 11, lines 13-15) with hydroxyalkyl methacrylate and aliphatic diols/polyols (column 7, lines 57-59, the only compound having a double bond being methacrylate.

Applicants respond that Betz et al. do not teach or suggest the present invention because there is no reaction of a polyisocyanurate of hexamethylene (hexane) diisocyanate (HDI) with hydroxyalkyl methacrylate. Instead column 11, lines 13-15 describes the reaction of the isocyanurate trimer of HDI with diethyl malonate and ethylacetoacetate, which results in the formation of a typical blocked polyisocyanate. The diethyl malonate and ethylacetoacetate each serve as blocking

agents and they add, by way of their CH-acidic group, to the NCO- groups of the isocyanurate trimer of HDI.

Furthermore, Applicants believe Betz et al. actually teaches away from the present invention and thus cannot inherently anticipate or even suggest the present invention. The compounds described by Betz et al. and those of the present invention are fundamentally different because Betz et al. describes the use of blocked polyisocyanates whereas the present invention describes the use of urethane (meth)acrylates. Each class of compound is utilized in very different coating systems, wherein those skilled in the art would not look to Betz et al. for guidance or teachings in order to result in the present invention. More particularly, the blocked polyisocyanates cross-linking agents according to Betz et al. are utilized in conjunction with thermal curing. The blocked polyisocyanates are typically combined with OH-functional binders, wherein upon baking (thermal curing), the deblocking occurs thereby allowing for the rebuilding of free NCO groups that cross-link with the binder OH- groups. In direct contrast, the urethane (meth)acrylates according to the present invention are self-cross-linking binders utilized in conjunction with radiation-curable coating. The urethane (meth)acrylates are not utilized with thermal curing because the cross-linking agent does not require any deblocking to occur, instead the urethane (meth)acrylates react and self-cross-link by free-radical polymerization of their (meth)acrylate group upon being subjected to UV radiation. The Examiner asserts that Betz et al. do describe unblocked diisocyanates in column, lines 14-19, however, Applicants believe that column 7, lines 15-16 simply describes how polyurethane (meth)acrylates can be prepared and the components to do so, which includes the use of free (unblocked) polyisocyanates. However, the NCO- groups are reacted with OH- groups of polyols as well as of hydroxyalkyl (meth)acrylates, there are no conventional groups formed for blocked polyisocyanate hardeners intended to be used in thermosetting coatings. In effect, to arrive at Applicants' invention, the Examiner has used impermissible hindsight examination and reconstruction of the invention from the art using Applicants' application, which is an improper basis for a rejection. Thus, Betz et al. do not teach or suggest the present invention.

Betz et al. disclose the use of UV-curable coatings in both the claims (claims 5, 7 and 8) as well as in Examples 1-4, however Betz et al. does not teach or suggest a urethane (meth)acrylate based on a polyisocyanurate of hexamethylene

diisocyanate, other acyclic aliphatic diisocyanates having 8 C atoms or to the synthesis methods thereof. Betz et al., in their description or Examples, simply refer to urethane (meth)acrylates that are aliphatic commercial products, however, their composition is not apparent and no evidence is provided by Betz et al. that these commercial products have a composition within the scope of the present invention.

In light of the above-presented remarks, Betz et al. neither anticipates, either explicitly or inherently, nor suggests the present invention.

Rejection under 35 U.S.C. § 103

Claims 23-24 stand rejected under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 6,261,645 (Betz et al.). More particularly, the Examiner asserts that The Examiner correctly notes that Betz fails to teach that the clear topcoat is applied to areas of outer finish susceptible to scratching (Claim 23) such as near locks, door handles, etc. (Claim 24), but asserts that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have applied a coating composition of Betz et al. to areas of outer finish susceptible to scratching such as near locks, door handles, etc. with the expectation of providing the desired scratch resistance, since Betz et al. teach that the coating composition is scratch resistant (See column 2, lines 61-67; column 3, lines 1-8) and is particularly suitable as a topcoat for producing a multicoat finish in the sector of the automotive OEM finishing and/or automotive refinishing (i.e. over outer finish) of car bodies and parts thereof and also truck bodies, and the like (See column 10, lines 1-5).

Applicants respectfully assert that Claims 10-22 are not obvious in light of Betz et al. for the same reasons already set forth hereinabove, and thus, since Claims 23 and 24 depend from Claim 13, Applicants believe these claims to be patentable.

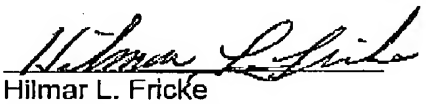
Summary

In view of the foregoing amendments and remarks, Applicants submit that this application is in condition for allowance. In order to expedite disposition of this case, the Examiner is invited to contact Applicant's representative at the telephone number below to resolve any remaining issues.

Applicants believe that the fee for a one-month extension of time of the period for reply is due in accordance with the filing of this Response, therefore please

charge such fee to Deposit Account No. 04-1928 (E.I. du Pont de Nemours and Company). Additionally, should there be a fee due which has not been accounted for, please charge such fee to Deposit Account No. 04-1928 (E.I. du Pont de Nemours and Company).

Respectfully submitted,



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